

## REMARKS

Firstly, Applicants wish to thank the Examiner for entering the amendments made to the specification and for acknowledging the sequence data submitted in electronic format that accompanied Applicant's previous response.

Applicants also wish to thank the Examiner for allowing claim 23 and for agreeing to examine claims 44 and 50 submitted with the previously mentioned response.

The Applicants respectfully request entry of amended claims 49 and 50 and reconsideration of all claims previously pending 11-17, 23-27, 34 and 37-50. It is believed that all claims are in condition for allowance, and thus reconsideration and allowance of this application are requested.

Claims 11-17 and 23-27 stand rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed to the extent maintained against any remaining claim.

As partial basis for this final rejection, the Examiner asserts that the Applicants' previous arguments for patentability of the claims are unpersuasive. And that only the sequences enumerated in SEQ. ID NO. 2 or SEQ. ID NO. 4 are sufficiently described to warrant patent protection. The Examiner also states that, "the number of sequences that share 70% identity are enormous compared to the single two separate species of with SEQ ID NO 2 and 4 disclosed," and further that, "the specification fails to provide any clear guidance to any other sequences encompassed by the claim". Office Action, Final Rejection, pg. 5.

The rejection implies that the only functional nucleic acids described in the specification are those enumerated in SEQ. ID NOS. 2 and 4 and that no other information is provided concerning which elements of these sequences are important to activity. This

analysis fails to fully appreciate the disclosure of Example 4 and accompanying figures. See Specification, pgs 40-42; figures 7 and 8. Experiment 4 describes generating of a series of truncation mutants of the p193 protein and testing these constructs to determine their effect on apoptosis and cell proliferation.

Those of ordinary skill in the art, relying on the teachings of example 4 would know which nucleic acid sequences derived from SEQ. ID NOS. 2 and 4 to make in order to form nucleic acid constructs with p193 activity, and p193 like activity. Confirming these results of example 4 and forming similar nucleic acids would not require undue experimentation.

Because, the specification describes functional variants of SEQ. ID NOS. 2 and 4 that can be readily made those skilled in the art, having read and understood the full disclosure of the specification would not seek to make every conceivable variant of p193 with 70% identity to the explicitly described sequences but would concentrate on portions of the sequence that were required for activity as disclosed in example 4. Therefore the application fully describes functional nucleic acids with 70% or more percent identity to p193 and guidance for making the same. Accordingly, claims directed to the same are adequately described and should be allowed. In view of the foregoing, reconsideration and withdrawal of the claim rejection under the first paragraph of 35 USC § 112 is solicited.

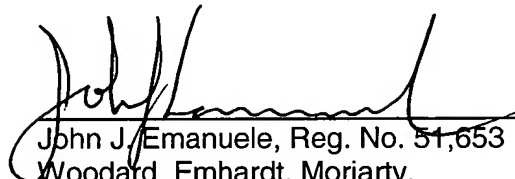
Claims 49 and 50 are amended to recite nucleic acids with 95% percent identity to SEQ ID NOS 2 and 4 respectively. Were only the Sequences listed in SEQ. ID NOS 2 and 4 described sequences with 95 percent to these arguably met the enablement and description requirements of 35 U.S.C. § 112. See Ex parte Bandman, No. 2004-2319 (BPAI 2005) (non-binding decision).

In view of the foregoing amendments and remarks, it is believed that this application is in condition for allowance containing claims 11-17, 23-27, and 34-48 and amended claims 49 and 50 (including rejoined method claims). Prompt action to that end is solicited. The Examiner is invited to telephone the undersigned attorney if there are any questions about

this submission or other matters that can be handled in that fashion to expedite allowance of this application.

Respectfully submitted,

By:

A handwritten signature in black ink, appearing to read "John J. Emanuele", written over a horizontal line.

John J. Emanuele, Reg. No. 51,653  
Woodard, Emhardt, Moriarty,  
McNett & Henry LLP  
Bank One Center/Tower  
111 Monument Circle, Suite 3700  
Indianapolis, Indiana 46204-5137  
(317) 634-3456